

REMARKS

Claim 8 is currently pending in the application. Claim 1 has been cancelled and claim 8 has been amended. The specification has been amended. Proposed drawing changes are being submitted herewith. Since the proposed claim changes only cancel a claim and correct an informality, the entry of the instant amendment is respectfully requested. The proposed claim changes do not require any additional search or examination time by the Examiner and place the claims in better condition for appeal.

The drawings stand rejected under 37 CFR 1.83(a) for not showing the first cutting edge of claim 1. Since claim 1 has been cancelled this objection has been obviated.

The drawings stand objected to under 37 CFR 1.84(p)(5) for allegedly including the reference numeral "860" in Figure 12 which reference numeral is not discussed in the specification. Applicants submit that in the drawings that were submitted in the last amendment, the reference numeral 860 was deleted from Figure 12 obviating this objection. Accordingly, Applicants are resubmitting the proposed changes to the drawings filed in the last amendment as part of the instant amendment for approval by the Examiner.

The Examiner has objected to the specification for allegedly not disclosing the first cutting wheel as having at least one notch. Since claim 1 has been cancelled this objection has been obviated. However, the Examiner's attention is directed to the last two lines of page 15 which clearly states that the first cutting wheel can also include notches therein.

The specification was also objected to for not providing an antecedent basis for the claim term "backing member". The specification has been amended as suggested by the Examiner to overcome this objection.

Claim 8 was objected to by the Examiner for having a minor informality which has been corrected by way of the instant amendment of claim 8.

The rejection of claim 1 under 35 U.S.C. 112, first paragraph, has been obviated by the cancellation of claim 1. Applicants do not agree with the Examiner's position since there is ample support in the specification for claim 1. However, in order to expedite prosecution, claim 1 has been cancelled.

Claims 1 and 8 stand rejected under 35 U.S.C. 102(b) as being anticipated by Yamauchi. This rejection is respectfully traversed.

In order for a rejection under 35 U.S.C. 102(b) to be valid, each and every element of the claimed invention must be taught by the prior art. In the instant rejection, the Examiner admits that there is no teaching or suggestion that the cutting device of Yamauchi is configured in a manner to produce the claimed castellated appearance in the mailpiece as claimed. The Examiner simply states that the Yamauchi device "is capable" of creating a castellated appearance. The problem with this logic is that the Examiner is making this statement based on the teachings of the Applicants' specification and not on anything taught in the Yamauchi patent itself. Such hindsight use of the Applicants' invention to provide the missing teaching of a reference is impermissible. Further, while the Examiner has set forth a rejection under 35 U.S.C. 102, it appears that his analysis is more of an obviousness rejection.

In addition to the above, the claimed second cutter wheel has vertical cutting edges 861 that extend perpendicular to and downward from the cutting edge of the cutter wheel 859. Yamauchi does not teach or suggest such vertical cutting edges. In Yamauchi, the Examiner refers to the edges 23, 24 of recess 21 as being the claimed vertical cutting edges. However, such is not the case. The edges 23, 24 do not extend downward from the cutting edge (no numeral) of the cutter wheel 18 but are

contiguous therewith since they are the sides of the recess 21 formed on the cutting edge of cutter wheel 18. Put in another way, they are not a separate cutting surface from that of cutter wheel 18 but only reflect the thickness of cutter wheel 18. This is completely different than the claimed vertical cutting edges which extend downward from the cutting edge 847 beyond its thickness. The Yamauchi device has a cutting wheel 18 that is similar to the cutting wheel 803 of the instant specification as shown in figure 10 of the instant application. Cutter wheel 803 has a cutting edge 847 which has notches 855 cut therein. These notches 855 form a notched surface that is part of the cutting edge 847 and are contiguous therewith but do not have any separate vertical cutting edges that extend downward from the edge 847 as the cutting edges 861 of Figure 12. It is submitted that Yamauchi does not teach or suggest the claimed vertical cutting edges.

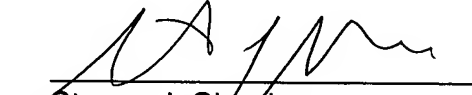
For the reasons set forth above, it is submitted that Claim 8 is neither anticipated by nor rendered obvious in view of Yamauchi. The Examiner cannot render the claimed invention obvious because, in his opinion, after reviewing the Applicants' specification, he believes the applied reference could be used in a manner to create a castellated appearance even though Yamauchi doesn't teach or suggest such use. The Applicants' claimed interaction of its cutter wheels to produce the castellated mailpiece is clearly directed to patentable subject matter not taught by the applied references. Further, the claimed vertical cutting edges are neither taught nor suggested by Yamauchi.

The rejection of claim 1 in view of Gall and Cavagna has been obviated by the cancellation of claim 1.

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Amdt. Dated April 16, 2004
Reply to Office Action dated January 21, 2004

In view of the above, it is submitted that the application stands in condition for allowance. Reconsideration of the rejections and objections is respectfully requested and an early notice of allowance is earnestly solicited.

Respectfully submitted,



Steven J. Shapiro
Reg. No. 35,677
Attorney of Record
Telephone (203) 924-3880

PITNEY BOWES INC.
Intellectual Property and
Technology Law Department
35 Waterview Drive
P.O. Box 3000
Shelton, CT 06484-8000

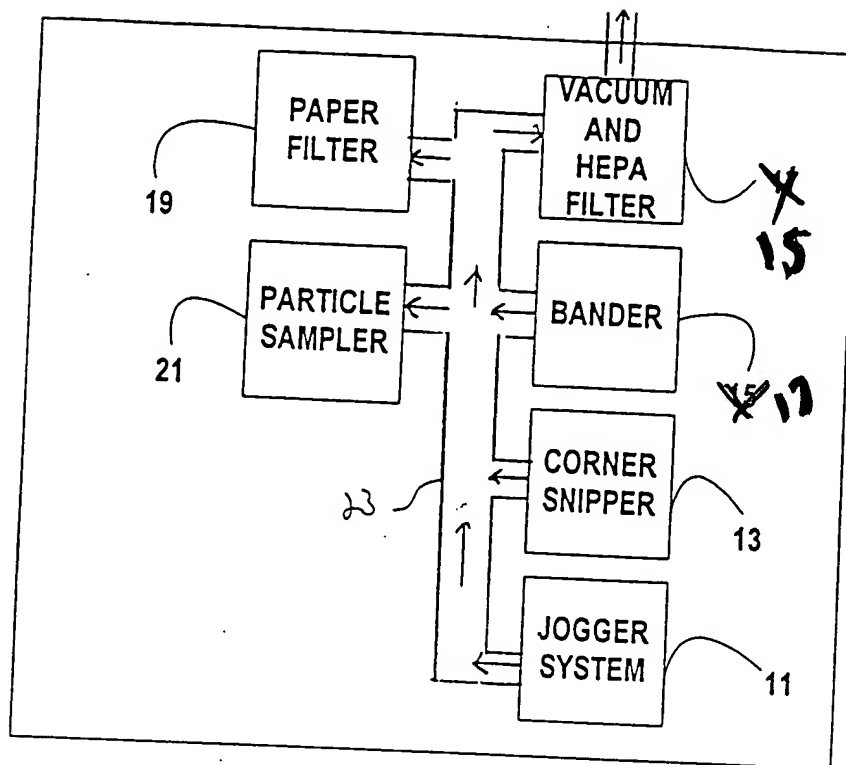


FIG. 2

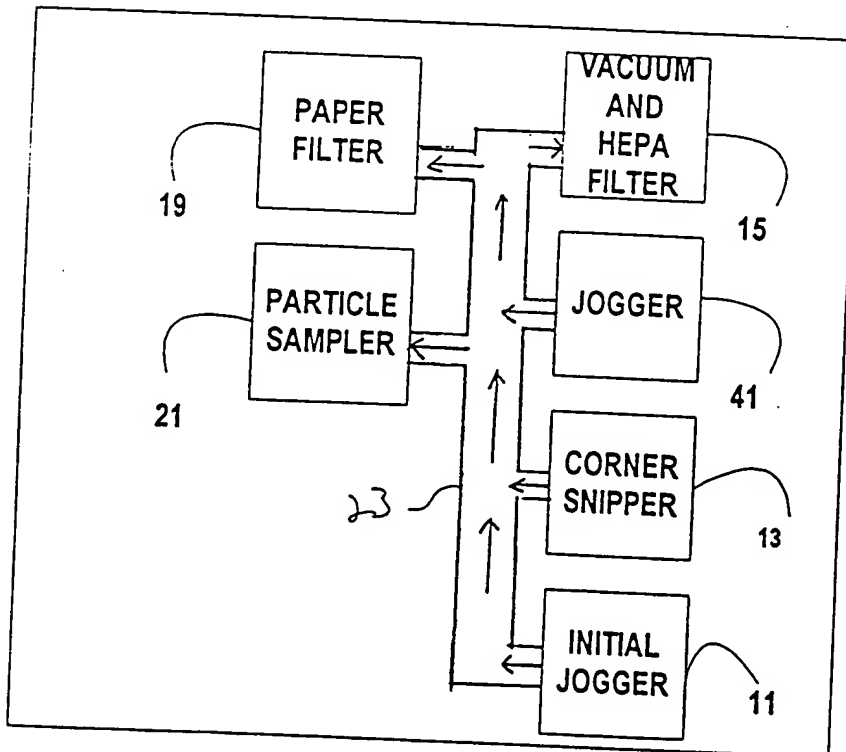


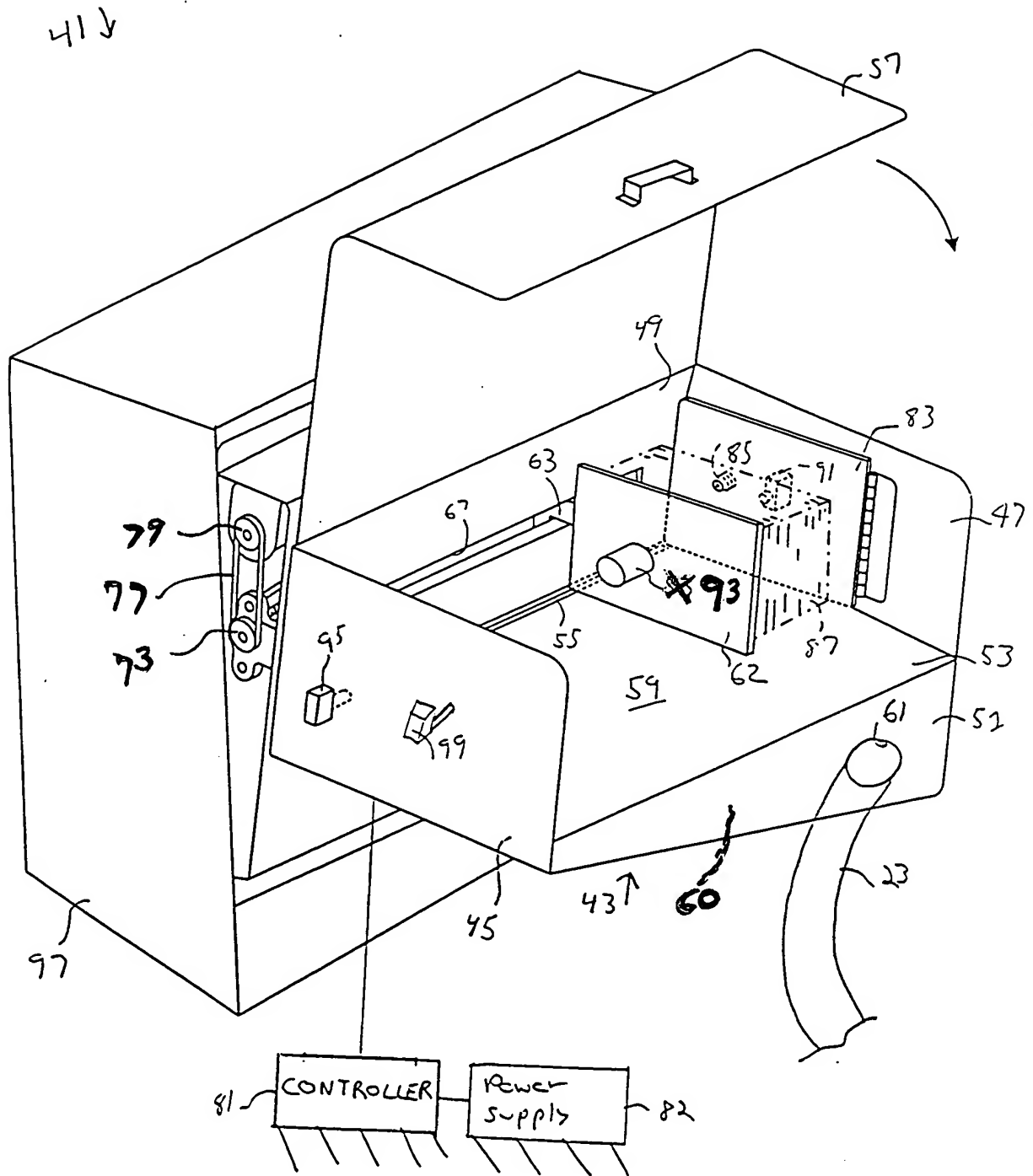
FIG. 7



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Changes

4/10

FIG. 4





5/10

FIG. 5

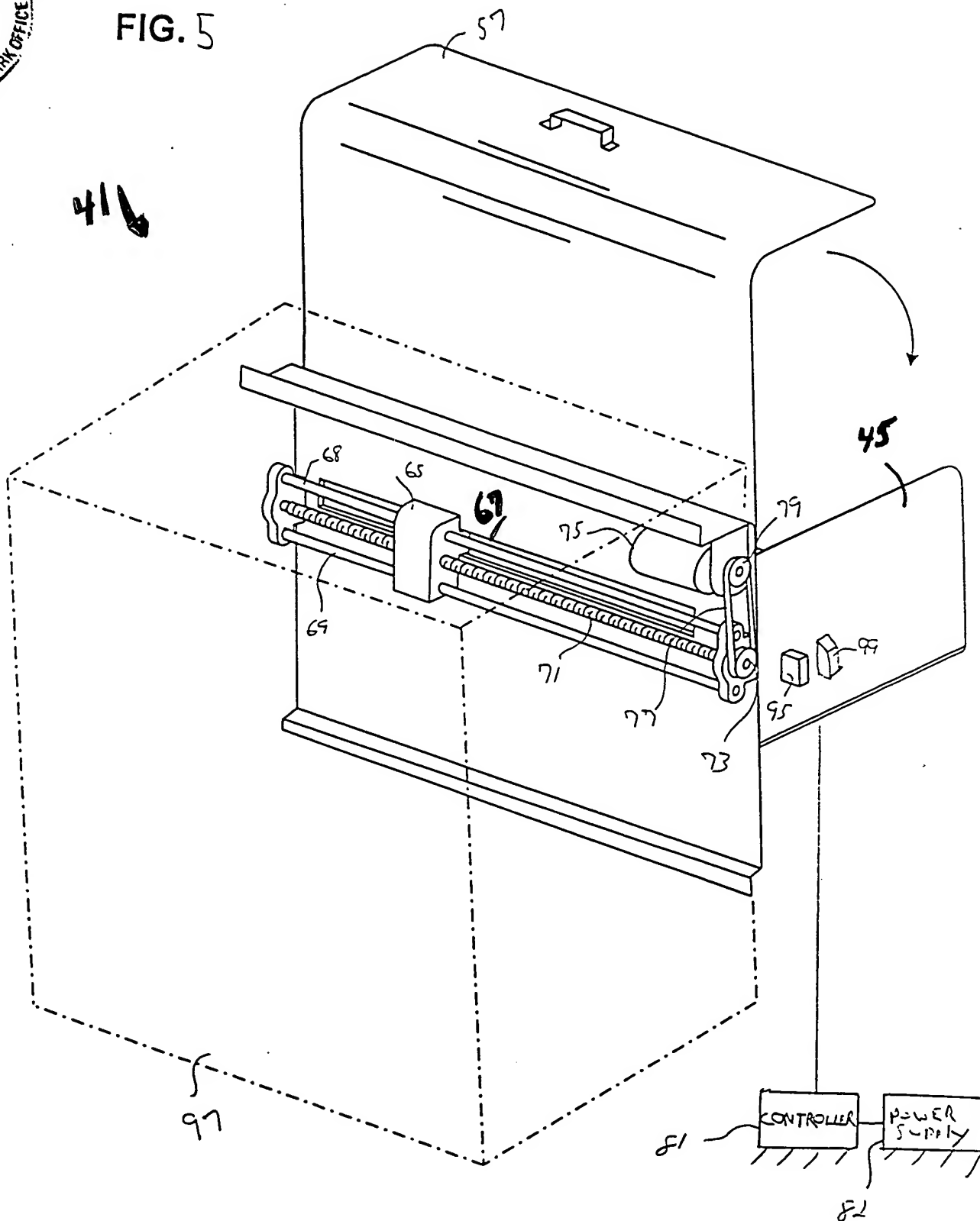




FIG. 6

6/10

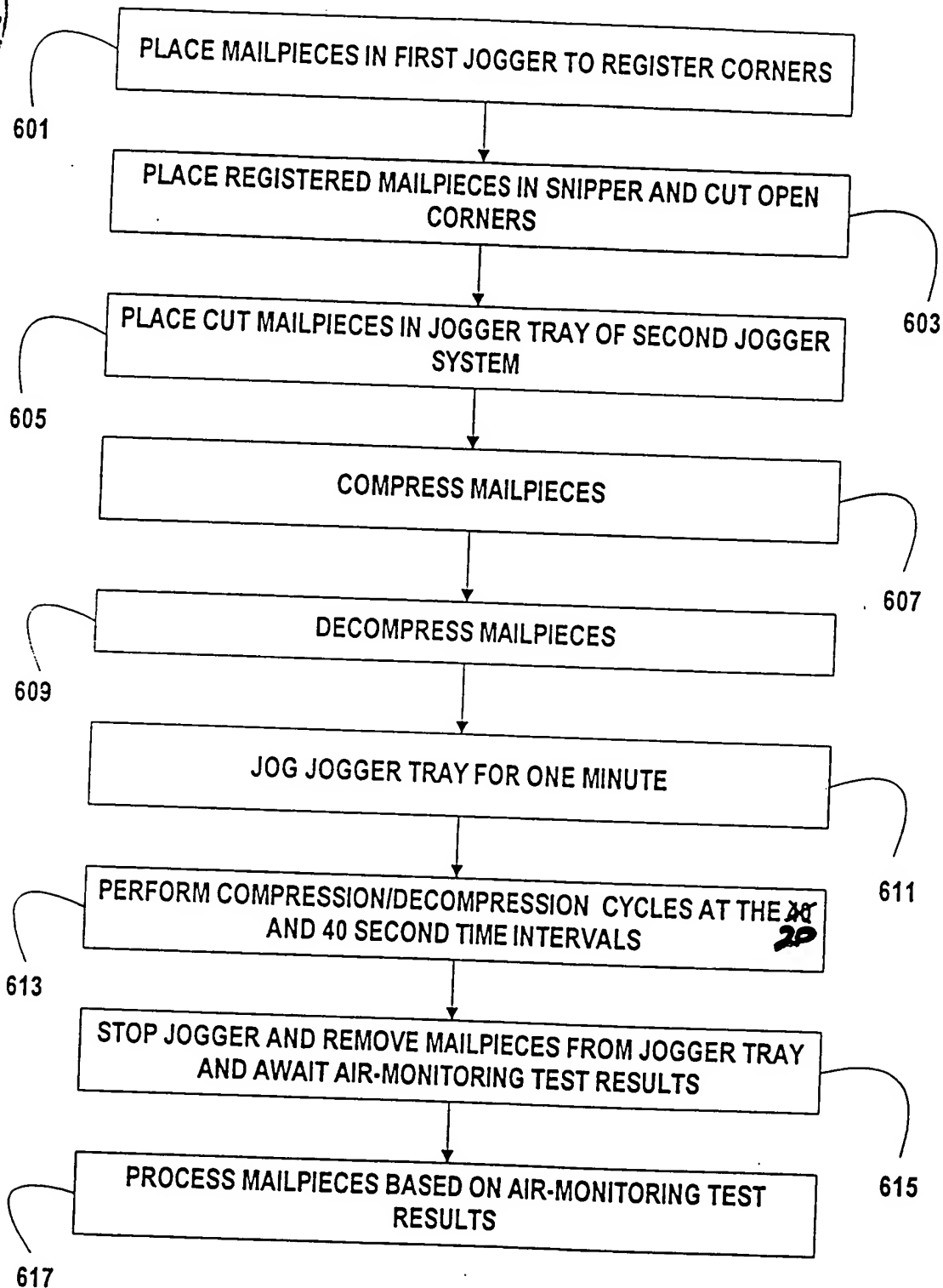




FIG. 9

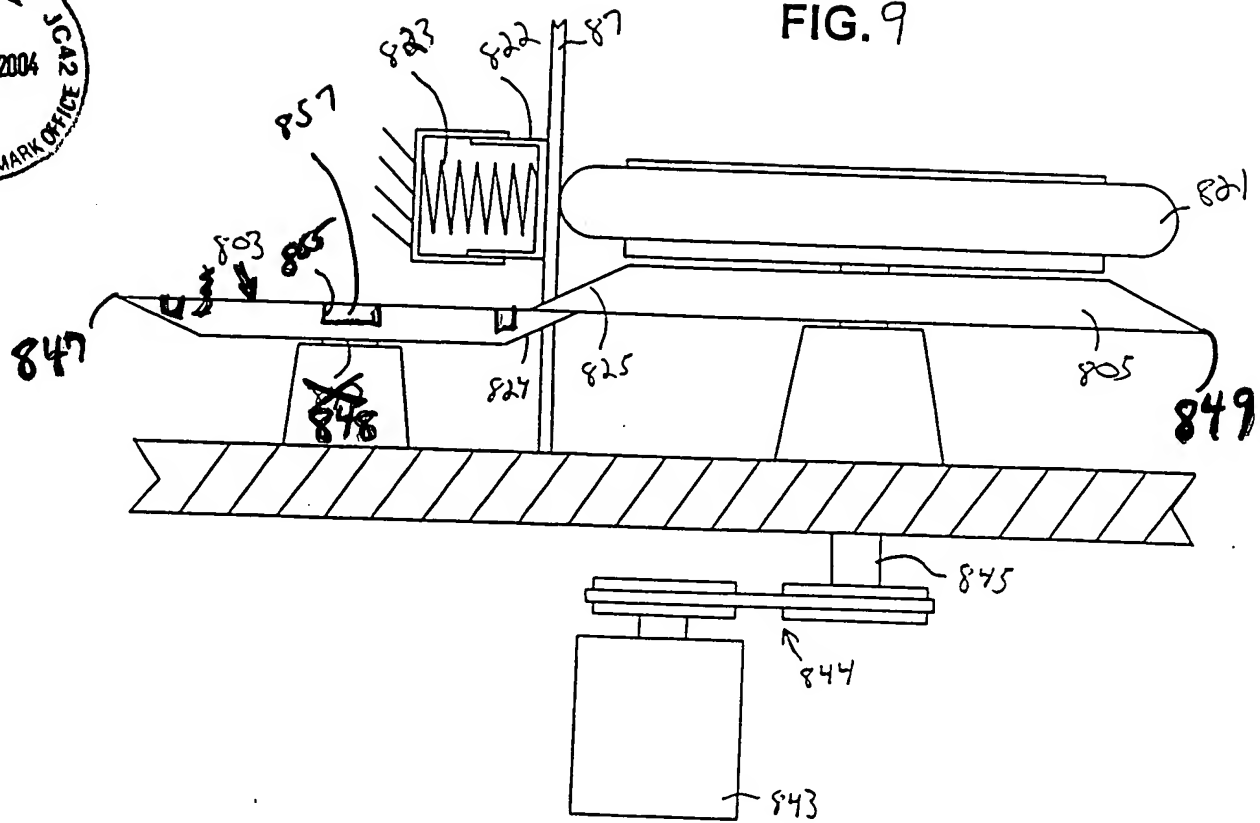
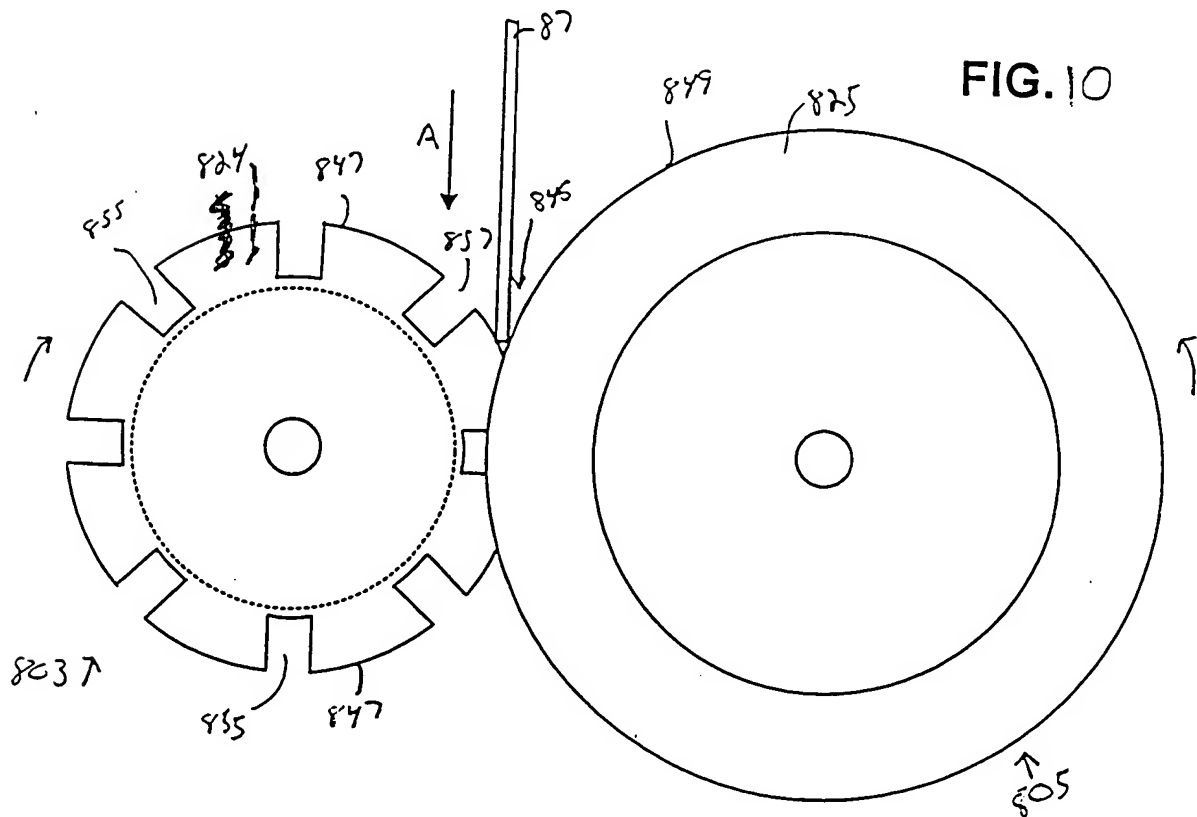
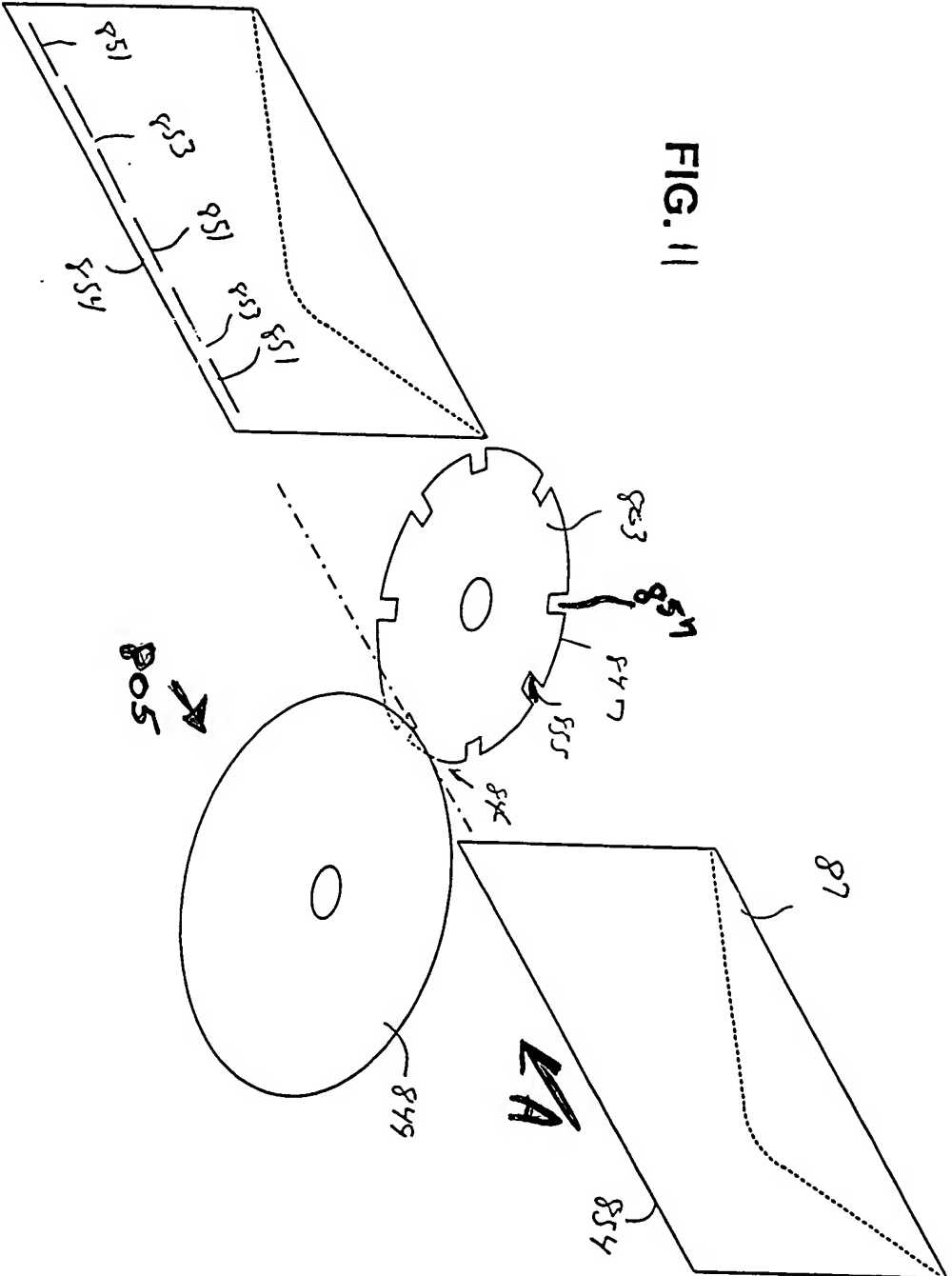


FIG. 10



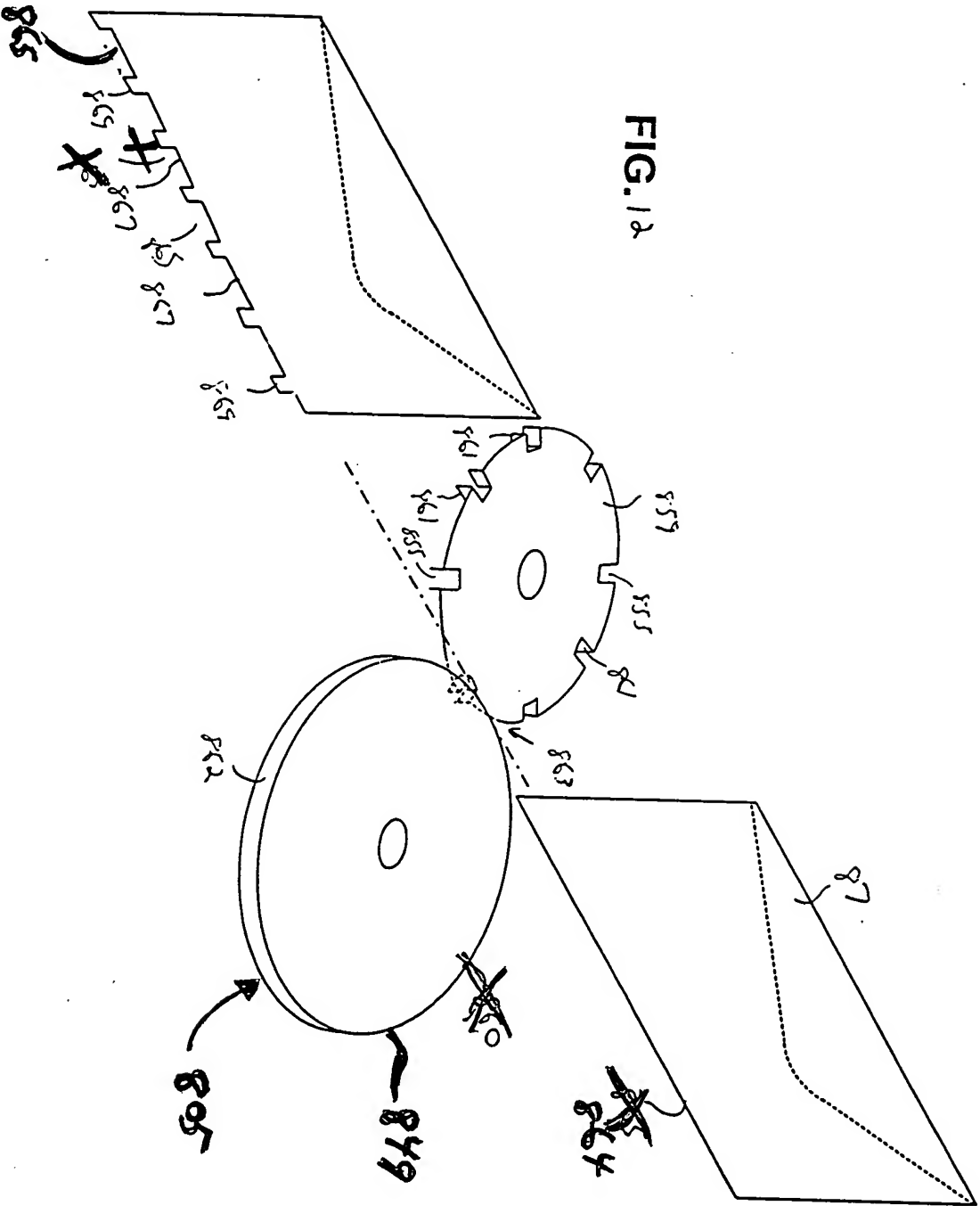
9/10

FIG. 11



10/10

FIG. 1a



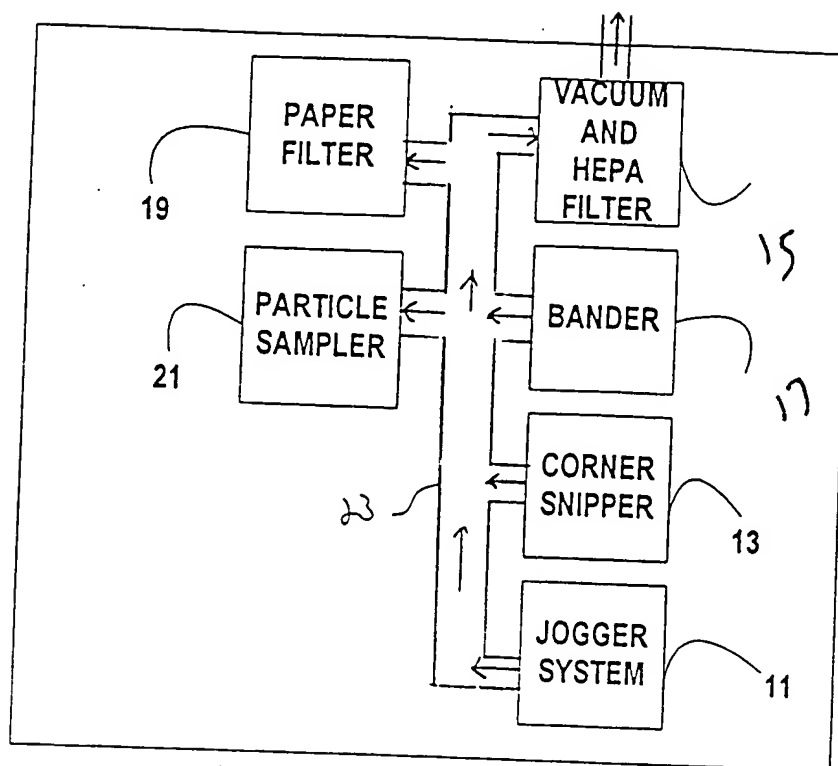
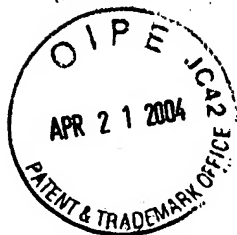


FIG. 2

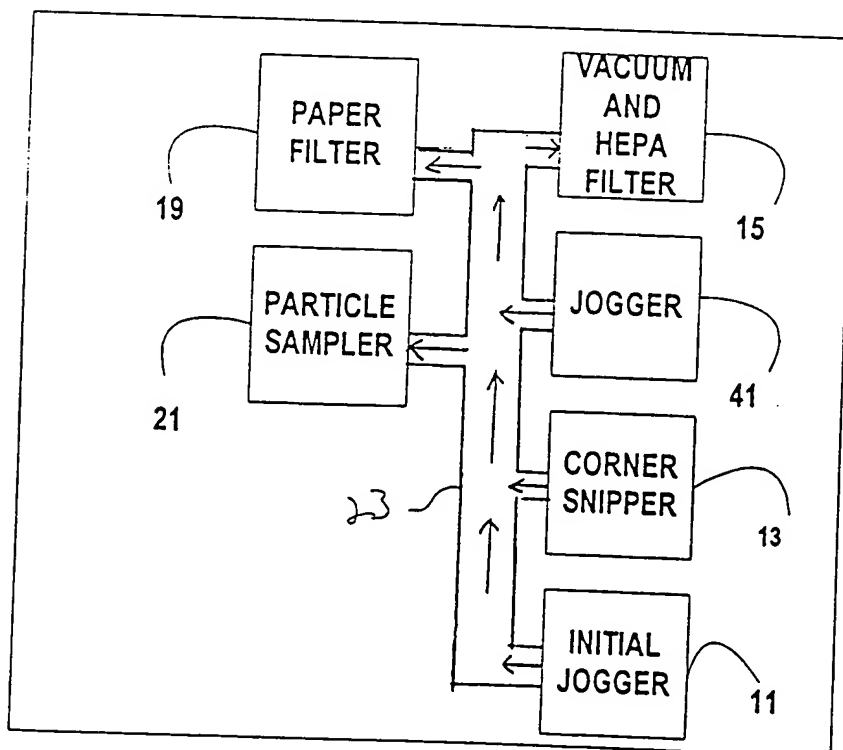
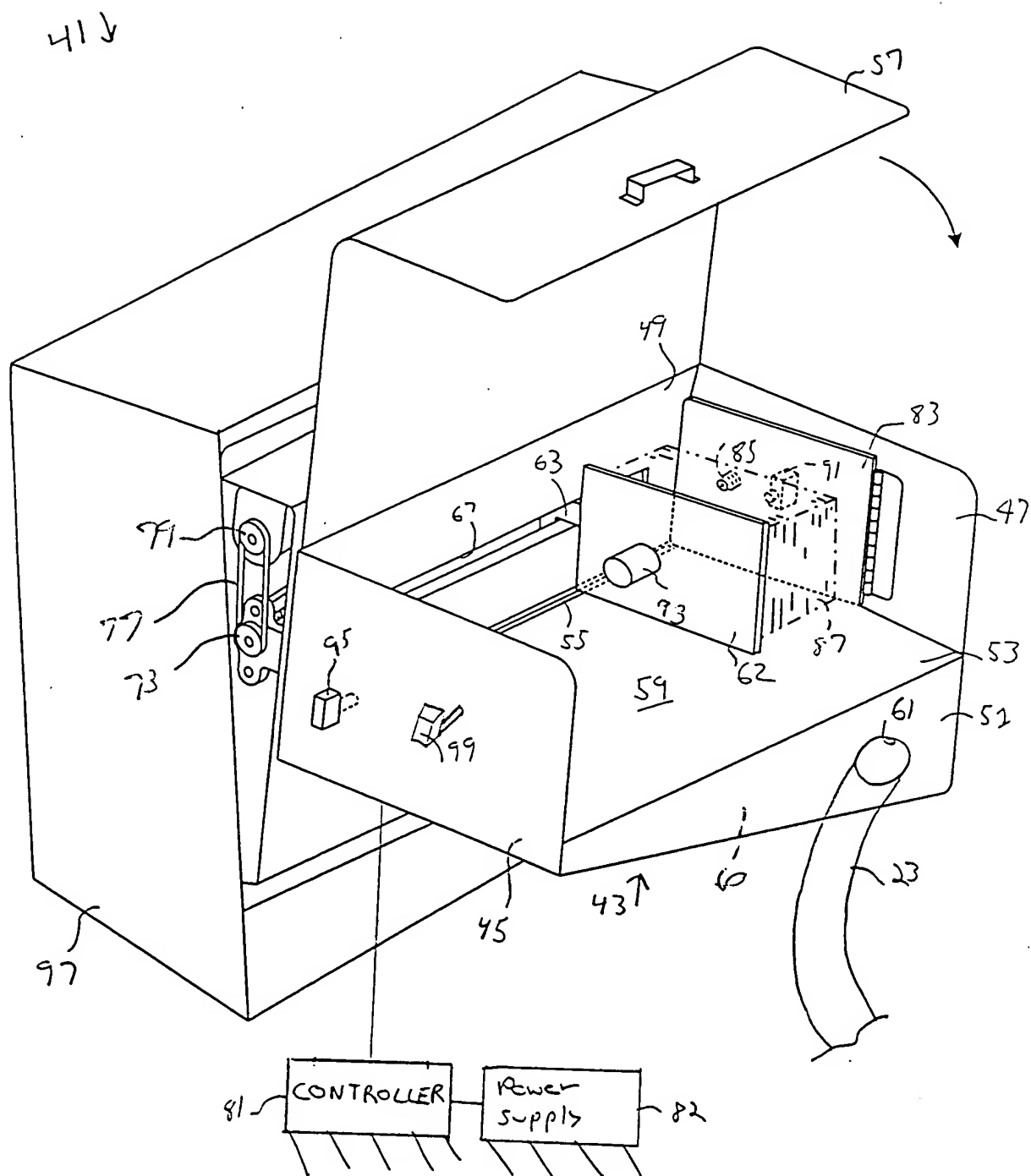


FIG. 7

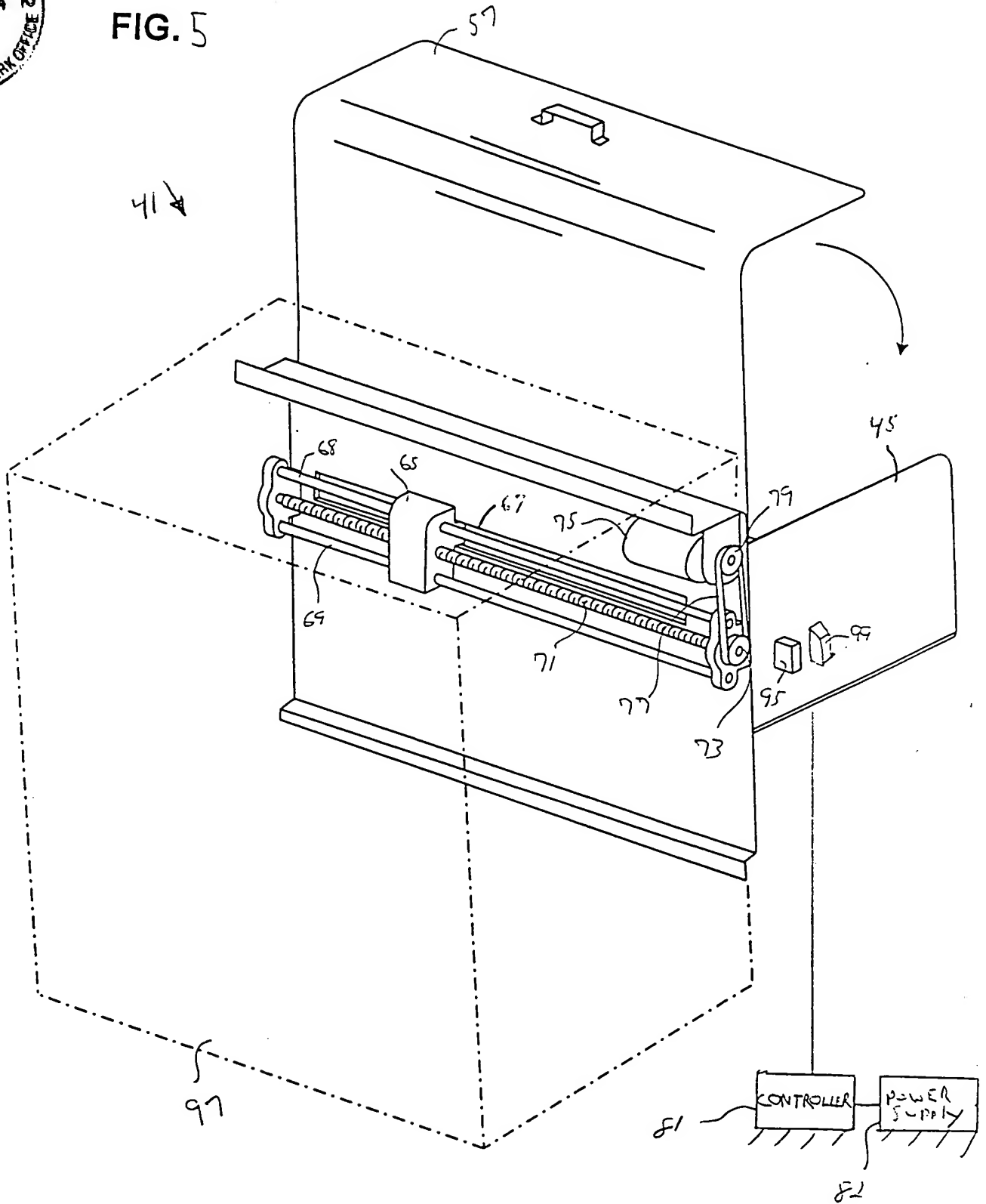
FIG. 4





5/10

FIG. 5



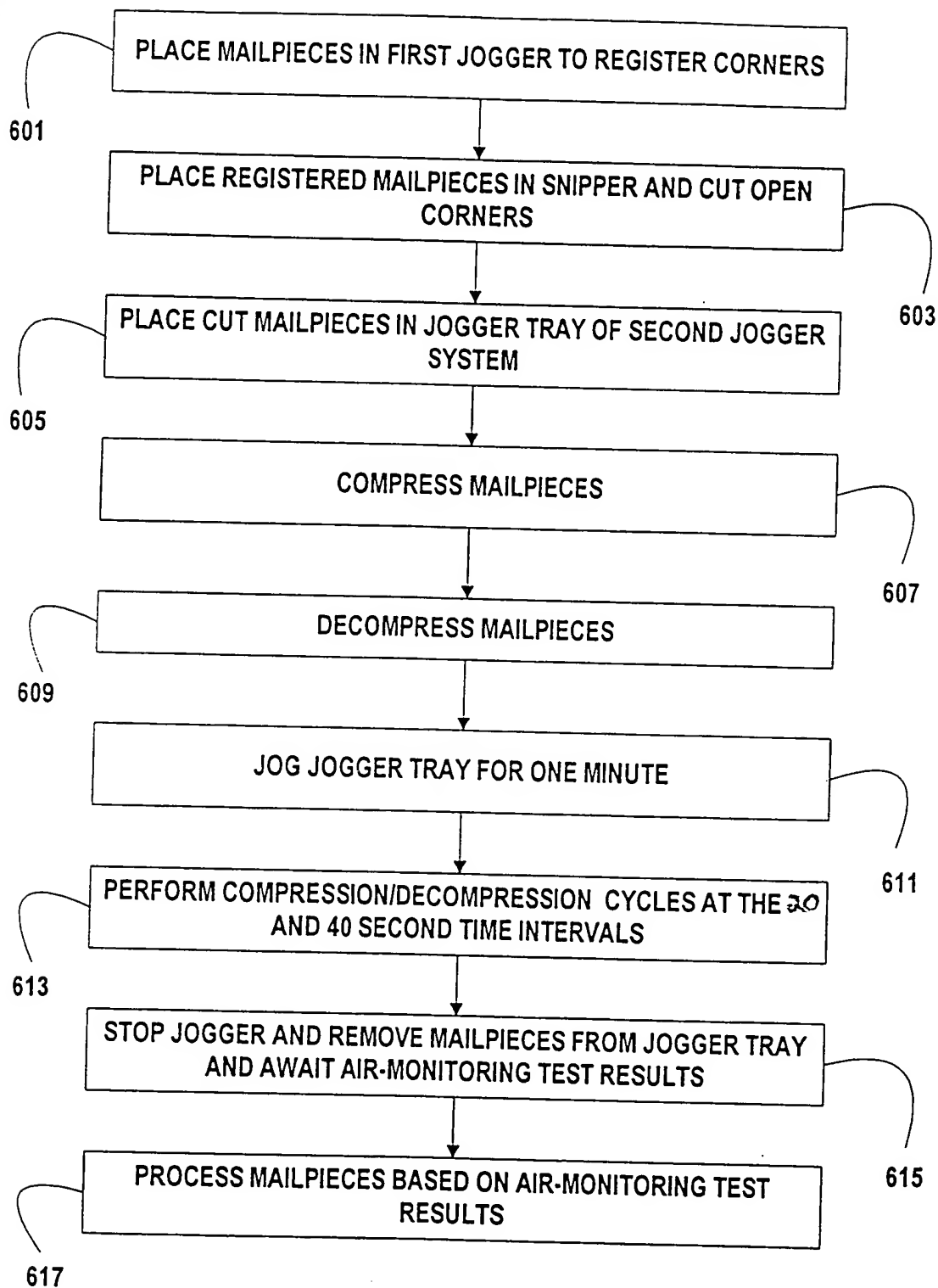


FIG. 9

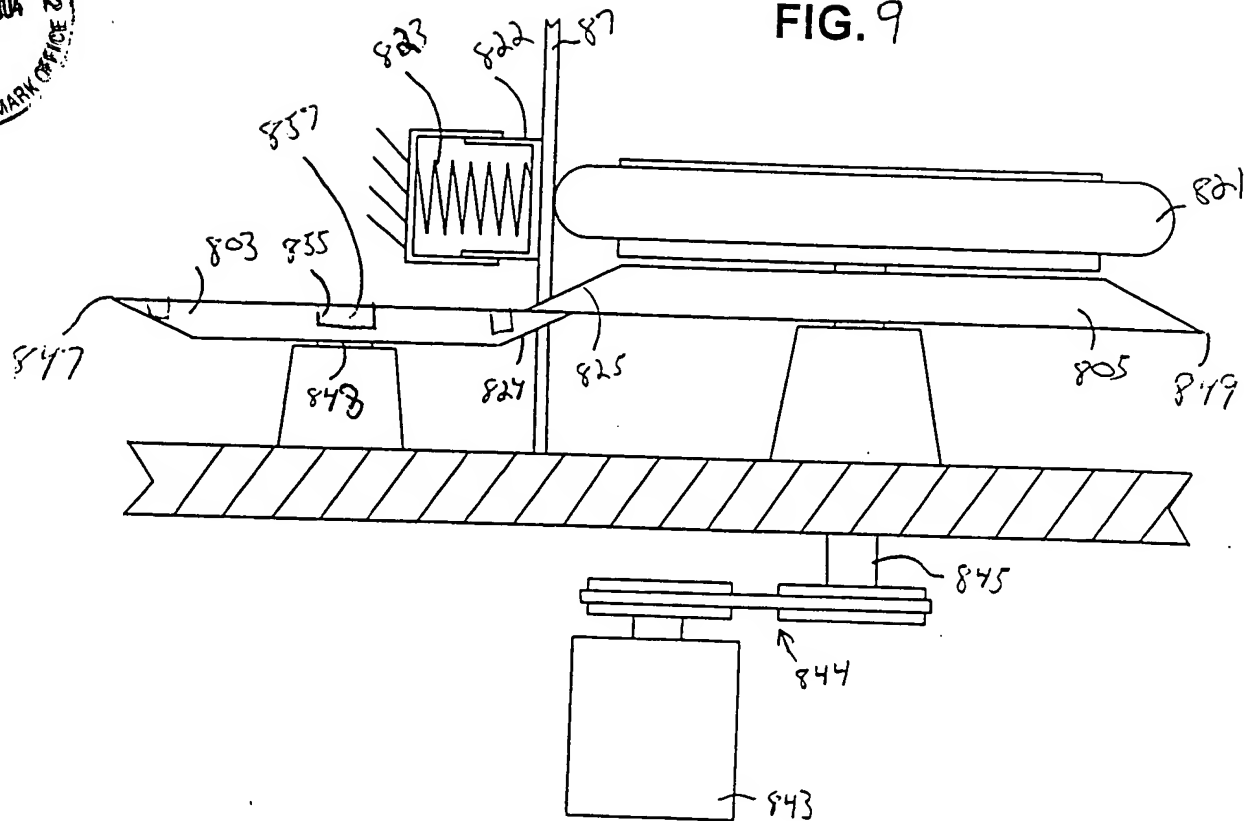


FIG. 10

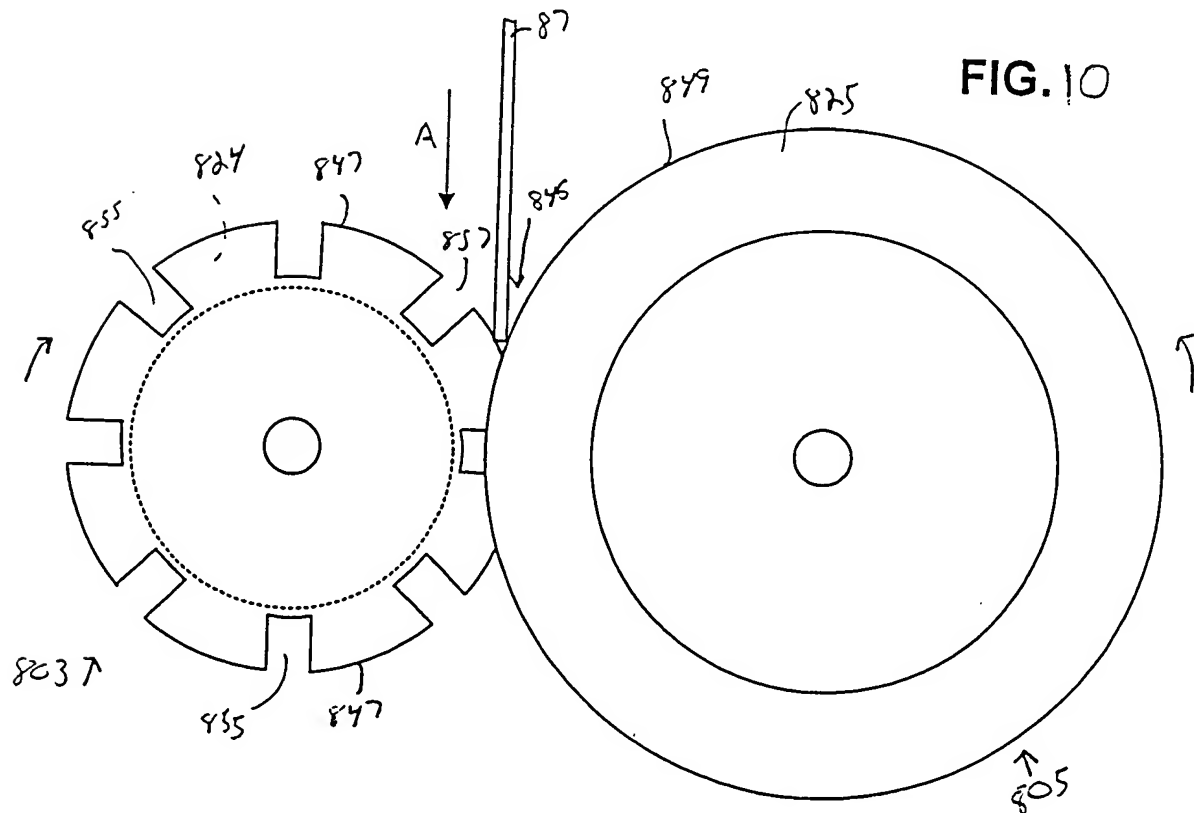
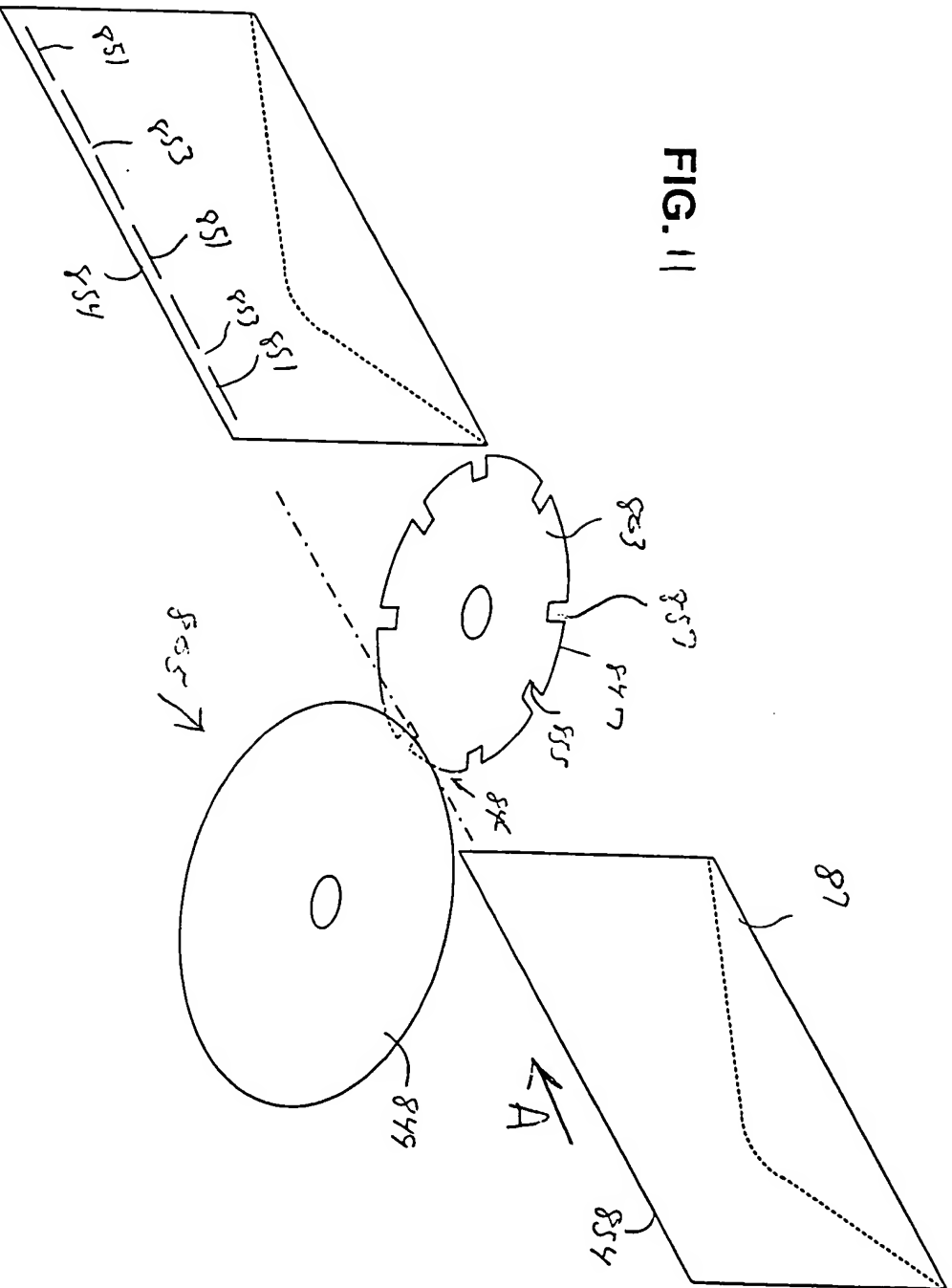


FIG. 11



10/10

FIG. 1a

